

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/395,805	09/14/99	KINOSHITA	H PM-264009

IM22/0927
PILLSBURY MADISON & SUTRO LLP
INTELLECTUAL PROPERTY GROUP
NINTH FLOOR EAST TOWER
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3918

EXAMINER

SHEWAREGED, B

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

09/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/395,805

Applicant(s)

Kinoshita et al.

Examiner

B t lhem Sh war ged

Group Art Unit

1774



☒ Responsive to communication(s) filed on Sep 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-3 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1774

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The applicant has failed to incorporate a foreign test standard in the specification.

3. The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicants attorney or agent, stating that the amendatory material consists of the same application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157; *In re Hawkins*, 486 F.2d 569, 179 USPQ 163; *In re Hawkins*, 486 F.2d 569, 179 USPQ 167.

4. In order to avoid a 35 U.S.C. § 112, first paragraph rejection when the applicant attempts to incorporate a foreign test standard in the specification (see page 12, line 33), it is recommended

Art Unit: 1774

that the applicant further incorporates the standard in the specification or submit an English translation of the standard.

OK 5. Claims 1-3 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

OK a. In claims 1 and 2, what is a KES? *page 3 line 9*

OK b. In claim 2, what is a value B? *page 14, lines 11-17*

Art Unit: 1774

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by kawatsu et al. (US 6,025,286).

A heat-sensitive stencil sheet comprises a fibrous support of polyester fibers, and a polyester film laminated on the fibrous support. Adhesive may be used for laminating the fibrous support and the polyester film. (Abstract, background art and claim 1). Since the prior art uses the same materials as the current invention, the prior art's invention possesses the claimed properties, (i.e. tensile strength, a value of T-H greater than or equal to 0.150).

Conclusion

10. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Betelhem Shewareged, whose telephone number is (703) 305-0389. The Examiner can normally be reached Monday to Thursday from 7:30 AM to 6:00 PM.

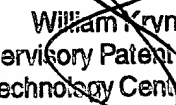
Art Unit: 1774

A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

BS *BS*

September 21, 2000.


William Krynski
Supervisory Patent Examiner
Technology Center 1700